

## **REMARKS**

The Applicants are filing this Response in response to an Office Action mailed November 21, 2006. At the time of the Office Action, claims 1-38 were pending. In this Response, no claims are canceled or added. Accordingly, claims 1-38 remain currently pending. Additionally, no claims are currently amended.

In the Office Action, claims 1-38 were rejected on the grounds of nonstatutory double patenting over claims 1-68 of the parent application. Also, claims 13-24 were rejected under 35 U.S.C. § 112, first paragraph, as not being enabled by the specification. Additionally, claims 1-2, 5-11, 25-26, and 30-38 were rejected under 35 U.S.C. § 102 as being obvious over U.S. Patent No. 6,331,855 to Schauser (“the Schauser reference”). Also, in the Office Action, claims 3, 4, 27, 28, and 29 were rejected under 35 U.S.C. § 103(a) as being obvious over Schauser in view of U.S. Patent No. 6,014,133 to Yamakado (“the Yamakado reference”). Each of these rejections is addressed in detail below.

### **Rejection for Nonstatutory Double Patenting**

In the Office Action, the Examiner rejected claims 1-38 on the ground of obviousness-type double patenting over claims 1-68 of the parent application, U.S. Patent No. 6,664,969. Although Applicants do not concede the correctness of the rejection, Applicants are willing to file a terminal disclaimer, if necessary, when the claims are indicated as being allowable.

### **Claim Rejection under 35 U.S.C. § 112**

In the Office Action, the Examiner rejected claims 13-24 under 35 U.S.C. § 112, first paragraph, because:

The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The features “*comparing the first block to the subsequent/second block, ... how many subsequent blocks equal the first block/if the first and second block are not equal*” is critical or essential to the practice of the invention, but are not found in the specification. The specification only recites comparing the hash code of the first block to that of the second block to find if they are equal, but does not disclose comparing the first block to that of the second block to find if they are equal.

Office Action, page 3. (Emphasis in original). Applicants respectfully traverse the rejection.

#### ***Legal Precedent***

Regarding the written description requirement, the initial burden of proof regarding the sufficiency of the written description falls on the Examiner. Accordingly, the Examiner must present evidence or reasons why persons skilled in the art would not recognize a description of the claimed subject matter in the applicant’s disclosure. *In re Wertheim*, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976). The Examiner is also reminded that the written description requirement does not require the claims to recite the same terminology used in the disclosure. The patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7th Cir. 1971), aff’d. 613 F.2d 775 (7th Cir. 1979), cert. denied, 446 U.S. 939 (1980). Moreover, any information contained in any part of the application as filed, including the specification, claims and drawings, may be added to other portions of the application without introducing new matter.

Contrary to the Examiner’s rejection, Applicants respectfully assert that the subject matter contained in independent claims 13 and 22 is sufficiently enabled by the specification. Specifically, the specification is sufficient to enable one skilled in the art to compare the first block with a second or subsequent block to find if they are equal or unequal. Referring to

FIG. 7B, “If the hash codes [for the blocks] are equal, processing branches from step 314 to step 316,” where it is determined whether the first screen is being processed. Application, page 16, lines 6-15; FIG. 7B. However, “if the hash codes are not equal, processing branches from step 314 to step 326 where the block compression pipeline is flushed to move any previously accumulated ‘block repeats’ into the transmit buffer 212. Next the new pixel block is compressed using the compression algorithm 210.” Application, page 16, lines 16-19; Fig. 7B. It is clear, therefore, that the specification does, indeed, disclose comparing the first block and a second or subsequent block. The specification further clearly explains what to do if the blocks are either equal or unequal. As such, one skilled in the art would have been enabled by the specification with regard to the subject matter of claims 13 and 22, regardless of whether the comparison of the first block to the second block indicated equality or inequality. Accordingly, Applicants respectfully request the withdrawal of the Section 112 rejection of claims 13 and 22, as well as all claims depending therefrom.

Should the Examiner wish to maintain the rejection, Applicants respectfully request that the Examiner specifically set forth the level of skill attributed by the Examiner to one skilled in the art such that the specification is insufficient to enable the subject matter of claims 13 and 22. In other words, Applicants request that the Examiner articulate how one skilled in the art would be unable to practice the subject matter of claims 13 and 22 in view of the specification. In the event the Examiner is unable or unwilling to specifically set forth the attributed skill level of one skilled in the art and the reasons why one skilled in the art would be unable to practice the subject matter of claims 13 and 22, Applicants request withdrawal of the rejection under Section 112 of claims 13 and 22, as well as the rejection of all claims depending thereon.

## **Rejections under 35. U.S.C. § 102**

The Examiner rejected claims 1-2, 5-11, 25-26, 30-38 under 35 U.S.C. § 102 as being anticipated by the Schauser reference. Applicants respectfully traverse the rejection because Schauser is not prior art to the instant application under any subsection of Section 102.

### ***Legal Precedent***

“When any claim of an application or a patent...is rejected, the inventor of the subject matter of the rejected claim...may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.” 37 C.F.R. §1.131(a). “The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference.” 37 C.F.R. §1.131(b). Accordingly, inventors may submit affidavits and evidence showing actual reduction to practice to remove a cited reference. *See* M.P.E.P. 715.04 and 715.07(III).

Applicants submit herewith a Declaration of Theodore F. Emerson under 37 C.F.R. §1.131 (“the Emerson declaration”) with accompanying Exhibits A and B.<sup>1</sup> Theodore F. Emerson is a co-inventor on the present application. The Emerson declaration, pg. 1, paragraph 1. As set forth in the Emerson declaration, and evidenced by Exhibits A and B thereto, the subject matter of the rejected claims was actually reduced to practice and worked

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<sup>1</sup> As set forth in the accompanying Declaration of Jeffery R. Peterson, Applicants’ representatives have diligently searched for Mr. Wesley Ellinger, who along with Mr. Emerson is a co-inventor of the instant application. Mr. Ellinger is no longer an employee of Hewlett-Packard Company. Despite these diligent efforts, Mr. Ellinger has not been located. Because Mr. Ellinger is not available, Applicants respectfully submit that the declaration of Mr. Emerson and the supporting evidence attached thereto is the best available evidence of the Applicants’ actual reduction to practice of the subject matter set forth in the instant claims.

for its intended purpose prior to April 28, 1999, which is the earliest priority date on the face of the Schauser patent.

The Emerson declaration describes the construction of an actual embodiment of the invention set forth in claim 1, prior to April 28, 1999. Exhibit A to the Emerson declaration is a document entitled “Remote Redirection of Graphical Console Data.” Mr. Emerson asserts that a device constructed in accordance with Exhibit A would meet the limitations of at least claim 1 of the instant application. Emerson declaration, ¶ 6. As set forth in the Emerson declaration, Mr. Emerson actually reduced to practice an embodiment according to the teachings of Exhibit A that meets the elements of claim 1. *Id.* at ¶ 7.

Specifically, treating claim 1 as a representative claim, Mr. Emerson actually reduced to practice a method for transmitting video graphics data, comprising:

dividing a screen into a number of blocks, the blocks having contents; *See* Exhibit A, pg. 3, Section 2 (Implementation), second paragraph (“The frame buffer is divided into blocks which consist of a rectangular block of pixels.”); pg. 4, Section 2.2 (Sampling Techniques), second paragraph (“The screen is divided into a plurality of blocks, each containing a rectangular block of pixels.”); Fig. 2-1. Emerson declaration, ¶ 6.

periodically reading the contents of each one of the blocks,” Exhibit A, pg. 3, Section 2 (Implementation), third paragraph (“The invention uses a modified sampling technique in conjunction with hardware assistance built into certain PCI video graphics controllers to procure data from the graphics frame buffer.”); pg. 4, Section 2.2 (Sampling Techniques), second paragraph (“Each block is sequentially procured, converted to grayscale, and encoded.”). *Id.*

computing a unique value for a first block based on the contents;” Exhibit A, pg. 3, Section 2 (Implementation), second paragraph (“A hashing algorithm is applied to the decimated pixels within the block to produce a 16 –bit hash value.”); pg. 5, Section 2.4 (Hashing Algorithm) (“From each pixel block, the gray scale values are fed into a hashing algorithm to generate a ‘signature’ for the pixel block.”). *Id.*

comparing the unique value for the first block to a previously computed unique value corresponding to the first block; *Id.* (“This value can be stored and compared in successive sampling periods”). *Id.*

transmitting the contents of the first block if the unique value for the first block is different from the previously computed unique value corresponding to the first block; Exhibit A, pg. 3, Section 2 (Implementation) (“If a block hash signature differs from a previously stored value, the block is transmitted to the management console.”), pg. 5, Section 2.5 (Data Encoding) (“When a block has been identified for transmission, the decimated grayscale value of the block are transmitted to the management console.”). *Id.*

Exhibit B to the Emerson declaration provides further evidence of the actual reduction to practice of the invention set forth in the claims of the instant application. Exhibit B is a source code listing of a computer program that meets the elements of at least claim 1.<sup>2</sup> *Id.* at ¶ 8. Again, using claim 1 as a representative claim, Mr. Emerson created the source code of Exhibit B to implement a method for transmitting video graphics data, comprising:

dividing a screen into a number of blocks, the blocks having contents; Exhibit B, pg. 12, (the relevant portion of the program has been hand marked with the legend “Section A”).  
Emerson declaration, ¶ 8.

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<sup>2</sup> In accordance with M.P.E.P. § 724, appropriate deletions of non-material portions of the source code have been made to protect proprietary information of the assignee of the instant application.

periodically reading the contents of each one of the blocks; Exhibit B, pg. 7, (the relevant portion of the program has been hand marked with the legend “Section B”). *Id.*

computing a unique value for a first block based on the contents; Exhibit B, pg. 6, (the relevant portion of the program has been hand marked with the legend “Section C”). *Id.*

comparing the unique value for the first block to a previously computed unique value corresponding to the first block; Exhibit B, pg. 6, (the relevant portion of the program has been hand marked with the legend “Section D”). *Id.*

Furthermore, Mr. Emerson executed a compiled version of the source code set forth in Exhibit B on a processor-based device prior to April 28, 1999 and it operated according to its intended purpose. Emerson declaration, ¶ 9.

In view of the extensive evidence set forth in the Emerson declaration and Exhibits A and B, the Applicants assert that the claimed invention was the subject of an actual reduction to practice prior to April 28, 1999. Accordingly, Applicants respectfully assert that the Schauser reference does not qualify as prior art under any subsection of Section 102. Therefore, Applicants respectfully request removal of the Schauser reference, withdrawal of the rejection under Section 102, and allowance of independent claims 1, 25, 37 and 38, as well as all claims depending thereon.

### **Rejections under 35 U.S.C. § 103**

The Examiner rejected claims 3, 4, 27, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over the Schauser reference in view of the Yamakado reference. Applicants respectfully traverse the rejection. As set forth above, the Schauser reference does not qualify

as prior art under any subsection of Section 102. Furthermore, Applicants assert that the Yamakado reference fails to disclose all the limitations of the independent claims 1 and 25, from which claims 3, 4, 27, 28 and 29 depend. Moreover, the Yamakado reference is not even alleged by the Examiner to disclose the limitations of independent claims 1 and 25 that are admittedly absent from the Schausler reference. For at least these reasons, Applicants assert that the requirements of a *prima facie* case for obviousness under Section 103 are not met. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 3, 4, 27, 28 and 29 under section 103.

### **Conclusion**

In view of the remarks set forth above, Applicants respectfully request reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

### **General Authorization for Extensions of Time**

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefor. Furthermore, Applicants authorize the Commissioner to charge the appropriate fee for any extension of time to Deposit Account No. 08-2025; Order No. NUHP:0168-1/FLE.

Respectfully submitted,

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